

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Brownholtz, <i>et al.</i>	Conf. No.:	6987
Serial No.:	10/722,014	Art. Unit:	2109
Filed:	11/25/2003	Examiner:	Dam, Kim Lynn
Title:	MULTI-COLUMN USER INTERFACE FOR MANAGING ON-LINE THREADED CONVERSATIONS	Docket. No.:	LOT920030034US1 (IBML-0029)

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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir or Madam:

Applicants respectfully request that a panel of experienced examiners perform a detailed review of appealable issues for the above-identified patent application pursuant to the Pre-Appeal Brief Conference Pilot Program. Applicants submit that the above-identified application is not in condition for appeal because the Office has failed to establish a prima facie case of obviousness based on an error in facts. Claims 1-40 are pending in this application.

Turning to the rejection in the Final Office Action, which is maintained in the Advisory Action, claims 1-3, 5-12, 14-27, 29-38, and 40 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Maurille (U.S. Pat. No. 6,484,196, hereinafter, "Maurille"), in view of Newman (U.S. Pat. No. 7,003,724, hereinafter, "Newman"), and further in view of Borwankar (U.S. Pat. No. 6,594,693, hereinafter, "Borwankar"). Applicants submit that this rejection is clearly not proper and without basis because at least one claim limitation is not met by the combined features of the references cited by the Office. As argued in the After Final Response

of September 17, 2007, the cited references fail to teach or suggest each and every element of independent claims 1, 20, and 30.

As discussed in the After Final Response, Applicants submit that with particular respect to claim 1, Borwankar fails to teach or suggest the feature of a conversation map for illustrating relationships between messages in the conversation, wherein the conversation map changes according to the branch of messages displayed in the second column (After Final Response, p. 9, ¶ 3 *et seq.*). The Office admits that Maurille and Newman do not teach or suggest a conversation map, but cites Borwankar at col. 11, lines 30-42 to cure the deficiency of the combined disclosures (Advisory Action, p. 2). To this extent, the Office's statement applies to *persistence of information* associated with each message, including data such as: a list of conversations that the participant is part of, identification of messages that preceded the current message, participants involved, dates and times of messages, and under which conversations and sub-conversations they were sent (Borwankar, col. 11, lines 30-42). As such, however, the Office's statement does not support, teach, or suggest a user interface which includes a *conversation map* for *illustrating* relationships between messages in the conversation. Thus, the Office's statement amounts to Official Notice and the Office should be required to submit references that support this feature.

In the Advisory Action, the Office posits that "Borwankar disclosed making the information available to a participant in a conversation and is maintained at each client," [sic] and that "the schematic diagram is therefore the claimed 'conversation map'" (Advisory Action, p. 2). Applicants specifically object to the logical leap whereby maintaining and providing to a client such information about a message in a conversation, allegedly teaches, suggests, or would motivate one to create a *conversation map*. Applicants note that Merriam-Webster's Online

Dictionary (www.merriam-webster.com) defines a “map” as “a representation usually on a flat surface of the whole or a part of an area.” Applicants respectfully submit that nothing in the text of Borwankar teaches “a conversation map for illustrating relationships between messages in the conversation, wherein the conversation map changes according to the branch of messages displayed in the second column” (claim 1, lines 6-8). A map would require an actual *representation or illustration*, as opposed to merely adding the conversation and topic to the participant’s meta information (as at step 710), disclosed by Borwankar, and described with respect to FIG. 6 at block 600 and appropriate lists thereunder, as shown in block 602. (Borwankar, Col. 12, lines 3-5.) In short, whereas Borwankar merely retains this information persistently, the claimed invention includes an illustrative map of the conversation.

Further, Applicants note that the After Final Response contains an in depth discussion of the reasons why Borwankar’s FIGS. 6 and 7 also fail to teach or suggest the claimed invention, including the feature of a conversation map. (*See*, After Final Response, p. 10, ¶ 1.)

Accordingly, the Office has failed to state a prima facie case of anticipation, and this application is not in condition for appeal and should either be allowed as is, or re-opened for further prosecution.

With respect to the rejections of independent claims 20 and 30, Applicants note that each claim includes a feature similar in scope to the conversation map of claim 1. Further, the Office relies on the same arguments and interpretations of the cited references as discussed above with respect to claim 1. To this extent, Applicants herein incorporate the arguments presented above with respect to claim 1, and respectfully request withdrawal of the rejections of these claims for the above-stated reasons.

The dependent claims are believed to be allowable based on the above arguments regarding the claims from which they depend, as well as for their own additional features.

With further regard to the rejection as a whole, Applicants note that the Office's rejection of independent claim 1 seeks to combine three different references to support its obviousness rejection. To this extent, Applicants submit that it is unfathomable how the Office can maintain its contention that there is motivation or suggestion in the references themselves or elsewhere to combine such diverse references. This is further accentuated by the fact that each of the references performs a vastly different task. Accordingly, Applicants submit that the combinations that underlie the Office's rejections are flawed.

Applicants respectfully submit that the application is not in condition for appeal. Should the Examining Panel believe that anything further is necessary to place the application in better condition for allowance or for appeal, they are requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



/_____
Hunter E. Webb
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Date: October 17, 2007

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